

In the Application of:
Walter KUHN et al.
Serial No.: 10/565,241

REMARKS

Rejection of Claims under 35 U.S.C. § 102

Claims 1-2, 4-5, 7, 9-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Grob et al. The Examiner states that Grob et al. discloses the claimed limitations of the cis and trans isomers. Applicants respectfully disagree.

The Examiner misinterprets Applicants previous remarks in the present action (Action at p. 10). Applicants submit that Grob et al. fails to disclose a mixture of cis and trans isomers, as claimed. This is supported by the disclosure of Grob et al. The publication of Grob et al. discloses the production of cis-3,3,5-trimethyl-cyclohexyl formiate (substance 29c). This substance is produced by reacting a cis-alcohol with formic acid. The reaction product is then extracted using a Vigreux distillation column (see page 1394, 2nd paragraph after "Experimenteller Teil"). The raw product yield is 88.3 %, after distillation a yield of 85,4 % of cis-formiate 29c is obtained. The formation of the cis-product is separate from production of the trans-product, where the authors use a trans-alcohol. Thus, Grob et al. does not detail the formation of or a mixture of both the cis and trans isomers.

This is evidenced further by the fact that Grob et al. uses a 30 cm Vigreux distillation column for distilling the cis-isomer. One skilled in the art, knowing the proper use of a 30 cm Vigreux distillation column, would not use the same for preparing a mixture of cis and trans isomers. Therefore, when distillation was completed in Grob et al., there was no trans-isomer since no mixture of the cis and trans isomer is disclosed.

Specifically, if one skilled in the art were to follow the disclosure of Grob et al., no by-product would be produced as asserted by the Examiner. Applicants reassert that Grob et al. did

In the Application of:
Walter KUHN et al.
Serial No.: 10/565,241

not intend or expect for any by-products, as evidenced by their use of a 30 cm Vigreux distillation column. As stated above, use of the 30 cm Vigreux distillation column would not be used for preparing a mixture of cis and trans isomers. If Grob et al. intended to prepare a mixture, more elaborate equipment rather than a distillation column would have been used and described. In fact, Grob et al. simply discloses when starting from a cis-alcohol a cis-product (no mixture, only a cis-product) is obtained and when starting from a trans-alcohol a trans-product (no mixture, only a trans-product) is obtained. Any assertion by the Examiner that the cis or trans-alcohol use in Grob et al. **might** have been contaminated with the other isomer is purely speculative and not only unsupported by the disclosure of Grob et al. but actually proven untrue by that very disclosure. Thus, Grob et al. fails to disclose any trans-isomer, as claimed by Applicants.

As Grob et al. fails to disclose or suggest each and every element as recited in the independent claims, it cannot anticipate those claims. Thus, withdrawal of the 35 U.S.C. §102(b) rejections is respectfully requested.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-2, 4-5, 7, 9-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rhode et al. (hereinafter "Rhode") in view of Emura et al. (hereinafter "Emura"). As the Examiner acknowledged, Rhode fails to disclose the esters being either cis or trans as well as the ranges of at least 80% of the cis-esters and less than 20% of the trans-ester. However, the Examiner cites Emura for allegedly disclosing the use of high cis to trans ratio of "analogous perfuming materials."

With respect to Emura, it is directed specifically to 4-t-butylcyclohexanol acetate. Emura makes a general passing reference to a monograph by S. Arctander that allegedly details cis

In the Application of:
Walter KUHN et al.
Serial No.: 10/565,241

isomers having better fragrance qualities than trans isomers (col. 1, lines 20-26). Based on this, Emura concludes that 4-t-butylcyclohexanol acetate with an elevated cis content to be utilized in the perfume industry. However, Emura makes no reference to the claimed esters.


In citing the Emura reference, the Examiner states that “so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” (OA at p. 11). However, one skilled in the art, based on the passing reference in Emura to S. Arctander’s monograph, would not expect all “perfuming material” to have similar properties. As the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. V. Teleflex Inc.*, published October 10, 2007 state, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The Examiner cannot provide conclusory statements without support for his legal conclusion of obviousness. In this case, the Examiner has not clearly articulated how one skilled in the art would view a passing reference to perfuming articles to render obvious the claimed esters and ratio. Emura in no way gives any details to allow one skilled in the art to apply its disclosure to the claimed esters. Seemingly, the Examiner ignores completely that Emura is directed specifically to 4-t-butylcyclohexanol. Without undergoing undue experimentation, one skilled in the art would not expect a passing reference in Emura to be applicable to every chemical compound or mixture.

Thus, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103(a).

In the Application of:
Walter KUHN et al.
Serial No.: 10/565,241

Prompt and favorable examination on the merits is requested.

For the Applicants,

A handwritten signature in black ink, appearing to read 'R. Shah', written over a horizontal line.

Rajiv S. Shah
Registration No. 56,247

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, NW Suite 600
Washington, D.C. 20036-2680
(202) 659-9076

Dated: May 6, 2010